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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		09/616,469	July 14, 2000
		First Named Inventor	
		Michael P. Lyle	
		Art Unit	Examiner
		2134	Matthew E. Heneghan
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 40,661 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

William J. James

Signature

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Typed or printed name

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Telephone number

8/22/05

Date

<input type="checkbox"/> *Total of _____ forms are submitted.

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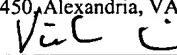
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor:	LYLE et al.	Examiner:	Matthew Heneghan
Application No.:	09/616,469	Art Unit:	2134
Filed:	July 14, 2000	Docket No.:	RECOP004
Title:	SYSTEM AND METHOD FOR PREVENTING DETECTION OF A COMPUTER CONNECTION TO AN EXTERNAL DEVICE		

CERTIFICATE OF MAILING

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Vicki Lorist

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The following remarks are respectfully submitted in support of Applicants' pre-appeal brief request for review filed herewith.

Claims 1-7 are pending. Claims 1, 6, and 7 are independent. Claims 2-5 depend from claim 1. The Examiner has rejected claims 1-7 under 35 USC 112, first paragraph, as based on a disclosure which is not enabling. Applicants' respectfully submit that the Examiner clearly erred in maintaining the non-enablement rejection despite compelling evidence to the contrary.

Claim 1 recites: configuring the external device to reply to any packet in which the required valid authorization information is not present *with the packet that would be generated by the computer in response to an attempt to communicate via the connectionless port at a time when no device was connected to the connectionless port.* (Emphasis added).

In rejecting claims 1-7 under 35 USC 112, the Office Action mailed on May 20, 2005 states, "Details about what would specifically constitute a 'packet that would be sent if the connectionless port were not in use,' critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." 5/20/05 Office Action ¶3, p. 2. The Office Action acknowledges that "Applicant discloses that an ICMP packet may be used, but does not specify which types of ICMP packets would be suitable," and that "it is clear that the invention could use a known sub-code when generating an ICMP message." However, the Office Action asserts "the functionality described in the instant application does not clearly conform to any one of the well-known definitions for the ICMP functions; therefore, it is necessary for the specification to designate a particular sub-code within ICMP in order for the disclosure to be enabling." 5/20/05 Office Action ¶3, p. 2-3.

As an initial matter, the 5/20/05 Office Action ignores the fact that the independent claims 1, 6, and 7 were amended in Amendment A, filed March 3, 2004 in response to the first office action (mailed 12/30/2003), to recite "the packet that would be generated by the computer in response to an attempt to communicate via the connectionless port at a time when no device was connected to the connectionless port" in place of "the packet that would be sent if the connectionless port were not in use", the limitation the 5/20/05 Office Action indicates is not enabled. Given the presence in the claim of the limitation as amended, and the absence of any language in the specification indicating the "not in use" wording is critical to the invention, the Examiner's assertion that a critical feature that is not enabled has not been claimed is clear error. MPEP 2164.08(c). However, it is true that the specification describes that in an embodiment in which the Internet Control Message Protocol (ICMP) is used, in the event a received message does not include a required authentication code "the administration console replies with the Internet Control Message Protocol (ICMP) packet that would be sent if the port were not in use." Application, page 39, line 1 – page 40, line 10. The revised limitation is supported, without limitation, by the above-cited portion of the specification.

Contrary to the assertion in the 5/20/05 Office Action, a person of ordinary skill in the relevant art would, at the time the above-captioned Application was filed, have understood from applicants' disclosure that "the Internet Control Message Protocol (ICMP) packet that would be sent if the port were not in use" refers to ICMP packet type 3, code 3, which is defined as "port unreachable". The ICMP is governed by a standard known as "RFC 792", entitled "Internet

Control Message Protocol DARPA Internet Program Protocol Specification,” dated September 1981, a copy of which was made of record herein as an attachment to the Declaration under 37 CFR 1.132 submitted by applicants’ undersigned representative in support of their Amendment B, filed July 6, 2004 in response to the office action mailed April 6, 2004. ICMP packet type 3, code 3 is the *only packet type* defined in the ICMP specification that includes the word “port” in its definition. Amendment B, p.5, citing the ICMP specification, at page 4 and throughout. The ICMP specification further describes ICMP packet type 3, code 2 (protocol unreachable) and ICMP packet type 3, code 3 (port unreachable) as follows:

If, in the destination host, the IP module cannot deliver the datagram, because the indicated protocol module or process port is not active, the destination host may send a destination unreachable message to the source host. ICMP Specification, page 5.

One of ordinary skill in the art would know from the above description that ICMP packet type 3, code 3, the packet the specification indicates should be sent if “the indicated ... process port is not active,” is the same packet that applicants refer to in their specification as the “packet that would be sent if the port were not in use” and, in an embodiment in which the ICMP protocol is used, “the packet that would be generated by the computer in response to an attempt to communicate via the connectionless port at a time when no device was connected to the connectionless port,” as recited in independent claims 1, 6, and 7. There is no meaningful difference between the port not being “active” and its not being “in use”, in this context, and similarly a port is neither “active” nor “in use” “at a time when no device [is] connected to the connectionless port,” as recited in the claims.

It is believed the above objective factual evidence is sufficient to traverse the rejection under 35 USC 112, first paragraph. However, when the rejection was maintained in the office action mailed 10/19/2004, applicants’ submitted a further Declaration under 37 CFR 1.132, from Brian Hernacki, a software architect employed by the sole assignee of the above-captioned application. Mr. Hernacki’s declaration makes clear that he knows the level of knowledge of those of ordinary skill in the art at the time of applicants’ invention and he states unequivocally that such a person of ordinary skill would know from applicants’ disclosure that in an embodiment in which the ICMP is used the “packet that would be sent if the port were not in

use" is ICMP packet type 3, code 3, "port unreachable". Hernacki 37 CFR 1.132 Declaration in support of applicants' Amendment C filed March 2, 2005.

The 5/20/05 Office Action discounts Mr. Hernacki's declaration on the grounds it did not provide supporting factual evidence and due to Mr. Hernacki's status as assignee's employee. 5/20/05 Office Action, ¶4, p. 4. The first basis fails to acknowledge that Mr. Hernacki's sworn declaration as to his opinion -- and his qualification to offer it -- is itself factual evidence, see MPEP 716.01(c)(III), and further ignores the previously-submitted ICMP specification, a wholly objective source that plainly supports Mr. Hernacki's testimony for the reasons stated above. While it may be appropriate to consider Mr. Hernacki's status as an employee of assignee in determining what weight to afford his testimony, it is not appropriate to disregard his testimony entirely on that basis, see MPEP 716.01(c)(III), especially in light to the separate and objective evidence presented in the form of the ICMP specification.

Claims 2-5 depend from claim 1 and are believed to be allowable for the same reasons described above. Like claim 1, independent claims 6 and 7 recite replying with "the packet that would be generated by the computer in response to an attempt to communicate via the connectionless port at a time when no device was connected to the connectionless port" and are believed to be allowable for the same reasons described above.

Reconsideration of the application and allowance of all claims are respectfully requested based on the preceding remarks. If at any time the Examiner believes that an interview would be helpful, please contact the undersigned.

Respectfully submitted,

Dated: 8/22/05

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